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SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1921.

No. 51 (old number 333).

HERBERT L. HILDRETH,
Petitioner,

v.

JIM M. MASTORAS,
Respondent.

REPLY BRIEF

ON BEHALF OF PETITIONER (HILDRETH).

GEORGE P. DIKE,
FREDERICK D. McKENNEY,
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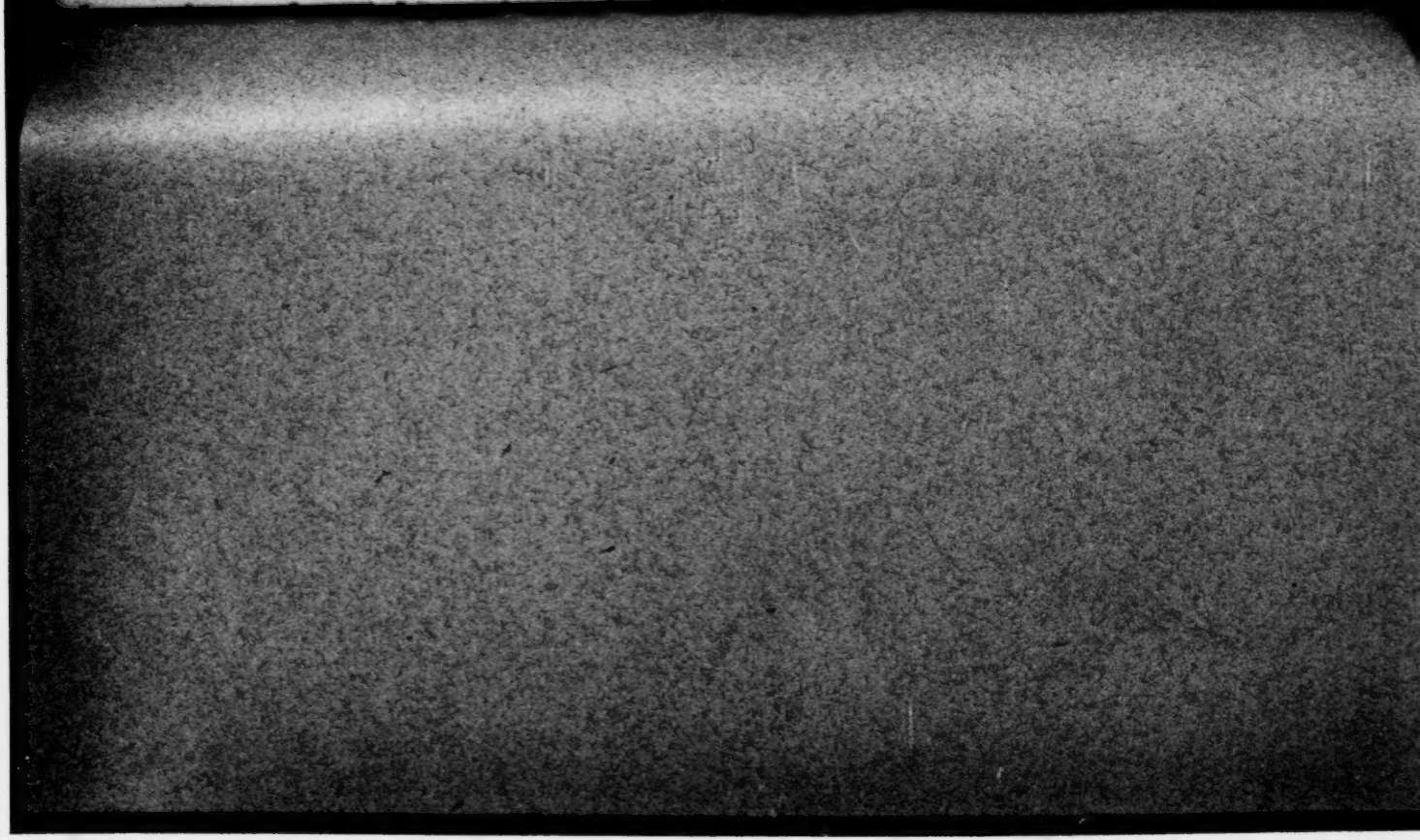

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HERBERT L. HILDRETH, PETITIONER,

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JIM M. MASTORAS, RESPONDENT.

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ON BEHALF OF PETITIONER (HILDRETH).

The following statement is made in reply to the argument contained in respondent's brief. Each point sought to be made by respondent's counsel is summarized and is discussed under headings and subdivisions corresponding to those employed in respondent's brief.

I.

RESPONDENT'S ARGUMENT THAT THERE IS NO CONFLICT BETWEEN THE DECISIONS OF THE FOURTH AND NINTH CIRCUIT COURTS OF APPEAL.

Respondent's counsel argue that there is no conflict between the decisions of the Fourth and Ninth Circuit Courts of Appeal and base this argument on a strict analysis of the facts of the two cases, saying in effect (first) that, as to the question of operativeness of the machine of the patent in suit, the Court of Appeals for the Ninth Circuit bases its decision solely on the question of infringement and that the statements as to operativeness are merely dicta, and (second) that on the question of

infringement there could be no conflict, because the two courts were passing on two radically different machines.

In reply, the following is respectfully submitted: —

(1) The question whether there is a conflict of opinion between the courts in question is not at issue in the present proceeding. While it was of vital importance when the petition for the writ of certiorari was under consideration, the only question now before the Court is whether or not the Ninth Circuit was correct in arriving at the conclusions expressed in its decree. That these conclusions were contrary to those of the Fourth Circuit is of no importance now, except as this Court may be influenced by the cogent reasoning of the Fourth Circuit.

(2) Respondent's argument is based on a futile attempt to show that the Fourth Circuit did not have before it all the facts. While it is true that the alleged infringing machines in the two cases were different, it is equally true that the Fourth and the Ninth Circuits took diametrically opposite views as to all the questions involved, and particularly as to operativeness, as to the effect of the prior art and as to the scope of the patent in suit. The Fourth Circuit held the patent in suit to be a pioneer patent of the highest character contributing a primary invention to the knowledge of mankind, and consequently gave claim 1 the broadest interpretation possible; the Ninth Circuit held the invention a mere improvement of a minor character and strictly limited the claim. To say that there was no conflict between the two decisions is to split hairs.

II.

RESPONDENT'S ARGUMENT THAT THE PATENT IN SUIT IS INVALID BECAUSE THE INVENTION IS NOT DESCRIBED IN FULL, CLEAR, CONCISE AND EXACT TERMS, AS REQUIRED BY THE STATUTES.

In reply, petitioner's counsel say (1) that this argument is an eleventh hour attempt to raise a defence which was not set up in the answer, and (2) that the specification does describe the invention with fullness and accuracy.

(1) The defence that the specification of a patent does not describe it in full, clear, concise and exact terms is one of the defences which must be set up in the answer.

Walker on Patents (5th Ed.), page 537, § 454, says: —

> "The twelfth defence [that the description of the patent is not in full, clear, concise and exact terms] is somewhat similar to the first member of the eleventh; but unlike that *it cannot be based on the general issue accompanied by notice;* . . . This defence must be interposed on a special plea; for neither the statute nor any precedent contemplates it being based on the general issue, either with or without notice; and *still less does any rule of law provide for its being made on the trial of an action without being pleaded at all.*"

(2) The alleged defect relied upon by the respondent in support of this part of its argument is that the specification does not describe all the minutiae of the mechanism by which the direction of rotation of the screw-shaft which slides the crosshead lengthwise of the trough is reversed.

Such reversing mechanism is common in many machines, substantially identical mechanisms being found in machine tools such as planers, in wood-working machinery, in textile machinery, and in tanning machinery. Anyone

familiar with machinery could instantly supply a satisfactory reversing mechanism if none were shown. One is shown, however, but respondent criticises its details. The criticism is at best trivial, but the whole subject is of no importance in the case because *the details of the particular reversing mechanism employed are no part of the candy-pulling mechanism which is the subject of the claims of the patent in suit.* No claim is made to the reversing mechanism as part of the patentee's novel invention and therefore any criticism of the description of the mechanism is wholly beside the mark.

On this point, Walker on Patents, pages 217–218, § 175, says: —

> "Neither is any description insufficient in the eye of the law, on account of any mere errors it may be found to contain, where these errors would at once be detected and their remedies be known, by any person skilled in the art, when making specimens of the invention set forth, or when practicing that invention, if that invention is a process; nor when such errors consist in mistaken statements of immaterial facts.

III.

RESPONDENT'S ARGUMENT THAT THE PATENT IN SUIT MAY BE SUSTAINED AND HELD NOT TO COVER RESPONDENT'S MACHINE IF IT IS LIMITED BY THE INCLUSION OF THE TROUGH.

The respondent says in effect that the trough shown in the drawings is an essential feature of the Dickinson machine and therefore is by implication an element of the claims.

This entire subject was dealt with by his Honor Judge Rose, in the opinion adopted by the Circuit Court of Appeals for the Fourth Circuit. He said: —

"There remains for consideration the first claim of the Dickinson patent. In terms it may be read upon the Henry machine. It is said, however, first, that there is implied, although not expressed in the Dickinson claim, an element which does not exist in the Henry machine, and that consequently there is no infringement. In the Dickinson machine the candy is put in a trough and is made to move over the bottom of the trough in a figure 8 path. The trough is the only thing which to any appreciable extent supports the candy against gravity. If there were no trough or substitute for it the candy would fall to the ground and the machine would be inoperative. Under these conditions the defendant says that the trough being an essential portion of an operative machine, constitutes a necessarily implied element of Dickinson's first claim.

"In passing upon this contention it must be borne in mind that in all the years during which this patent was before the Patent Office, no one ever supposed that a trough was an element of this claim. The office found this claim in effect in every one of the six applications as they were at first presented. It is certain that a trough did not constitute an element of that claim in any of the other five. But the interference was declared and so long contested because everybody understood that every one of the six applicants was making the same claim, not [211] only in words, but in fact.

"Dickinson and everybody else knew that in order that his puller and hooks could pull the candy, the candy must be where they could take hold of it. Some way of supporting it against gravity was an obvious necessity. It does not follow that the patentee is bound to make any one of these ways an element of

his claims. He shows a method of pulling candy in accordance with what he says is his inventive idea. In the illustration the candy is supported against gravity. That way of suporting it is not, however, a necessary element of his combination. He elected to make it an element of some of his claims, as, for example, of the fourth and the fifth. Wherever he has done so he is bound by it. Wherever he has not included it in words there is no reason to suppose either that he in fact intended to do so by implication or to say that the law will make the implication whether he wanted to or not. The new thing which he found out was not a trough, but the fact that if you give to a plurality of oppositely disposed candy hooks and a candy-puller a peculiar kind of in and out motion that will force the candy along the figure 8 path you will pull it. He was entitled to patent that combination. He had also the right to claim as a more restricted combination because limited by more elements, the very form of machine in which he had used that which was broader and more all embracing. If his claim for that larger conception is invalid either because it is in its nature a claim for the function of a machine, or because he failed to embody it in any operative device, it will be stricken down. That, however, is no reason for saying that he intended to include it in an element which it is absolutely certain he wanted to exclude." (See Rec. pp. 176, 177 and 178.)

Judge Rose's reasoning and conclusion are unassailable. Dickinson knew that the trough was not essential and therefore did not mention it in this claim; this being the case it will not now be read into it to save the respondent from the charge of infringement.

That a patentee is entitled to that interpretation which

upholds and vitalizes his patent and that an element not expressed in the claim will not be read into it unnecessarily, see

Winans v. *Denmead*, 56 U. S. 341;
Deering v. *Winona Harvesting Works*, 155 U. S. 286, 302;
Rubber Co. v. *Goodyear*, 9 Wall. 788, 795;
Consolidated Fastener Co. v. *Columbian Fastener Co.*, 79 Fed. Rep. 795, 798;
Gaisman v. *Gallert*, 105 Fed. Rep. 955;
Ryder v. *Schlichter*, 126 Fed. Rep. 487, 492.

IV.

RESPONDENT'S ARGUMENT THAT CLAIM 1 IS INVALID BECAUSE THE TERM "CANDY-PULLER" IS EMPLOYED, THEREBY RENDERING THE CLAIM VAGUE, INDEFINITE AND UNCERTAIN.

Respondent's counsel argue that the word candy-puller in claim 1 renders that claim vague and indefinite because that exact word is not to be found in the descriptive part of the specification, and therefore he concludes that its meaning cannot be determined from the specification. At best this is the result of wilful blindness.

The Dickinson machine as described in the specification and as claimed in the claims consists, when stripped of non-essentials, of three candy-engaging members and the mechanism to give them the relative in-and-out motion. The names given to these members are not important. It is not the name but the thing itself which has vitality as part of the machine. Called by other names, these three members would still perform their functions as before.

The three candy-engaging members of Dickinson's candy-pulling machine are the parts designated by the letters F, F' and G in the drawings and are referred to in

the descriptive part of the specification as pins or hooks. Claim 1 specifies "a pair of oppositely disposed hooks or supports and a candy-puller". That the pair of oppositely disposed hooks or supports refers to the parts F and F' is admitted by respondent's counsel and that the stationary pin G is the third candy-engaging member or "candy-puller" follows by exclusion since it is the only part not enumerated.

When it is concluded, therefore, as it must be, that the plurality of oppositely disposed pins or hooks are the parts F and F' and the candy-puller is the stationary member G, the claim is clear, certain and definite and respondent's tenuous argument falls to the ground.

V.

RESPONDENT'S ARGUMENT AS TO NON-INFRINGEMENT AND THE FIVE POINTS URGED IN SUPPORT THEREOF.

(a) That there is Lack of Identity between the two Machines and (b) that there is an Alleged Difference in Principle between the two Machines.

These matters have been fully dealt with in Petitioner's Brief (see pages 59–63) and will not be gone into in detail here. It is enough to say that respondent's alleged infringing machine corresponds in all essential particulars, and even in details, to the machine of the patent in suit. Respondent's machine is like the Dickinson machine in having (1) three candy-pulling pins, two of which are oppositely disposed, (2) the peculiar relative in-and-out motion discovered by Dickinson and without which no candy pulling machine can pull candy, and (3) identical successive positions of the candy during the cycles of movement. (See diagram facing p. 60 of petitioner's main brief.)

Such differences as exist are merely those of form and appearance. The machines certainly do not look in the

least alike and this as well as the reciprocating movements of the Dickinson machine seems to have misled the Court of Appeals for the Ninth Circuit. That court did not realize that mechanisms identical in substance may be clothed in widely different exteriors, and that a rotary movement is often the equivalent of a reciprocating one.

(c) Respondent's Argument that Infringement has been Established only by an Incompetent Witness.

This section of respondent's brief discusses several unrelated subjects only two of which require discussion.

In respondent's brief, counsel say, speaking of petitioner's expert witness, Livermore: "The witness does not testify from knowledge of any machine purporting to embody the alleged invention of the Dickinson patent. His speculations are based altogether upon his reading of the patent. Although there is in Petitioner's factory one machine alleged to constitute a mechanical embodiment of the subject-matter of the Dickinson patent, the witness knows nothing about it — has never seen it so far as his testimony shows." (Respondent's brief, pp. 43-44.) This statement gives a totally false impression. There is nothing whatever in Mr. Livermore's deposition to indicate whether or not he had ever seen a machine built like the Dickinson patent. To build an argument therefore on the assumption that he had not seen one, is certainly unjustifiable.

Furthermore, it is a novel doctrine that a mechanical expert in a patent case is not competent to testify as to the question of the identity of an alleged infringing machine with that of the patent in suit unless he had seen a machine made like the drawings of the patent and compared it with defendant's machine. Since the only possible field for the patent expert lies between the patent itself and the defendant's machine, to interject a machine built

like the patent in suit as the only standard of comparison is to mistake the shadow for the substance.

Respondent's counsel follows this argument by another equally novel, namely, that the plaintiff in a patent suit must prove affirmatively that the invention of the patent in suit has been reduced to practice. Just what respondent deduces from this argument is not clear; if it is that the patent is invalid, there is no foundation for it in defendant's answer.

As a matter of law, reduction to practice is of importance only in case the question of priority of invention is at issue as is the case in an interference, and, even in an interference, the filing of a complete application is the equivalent of a reduction to practice. In the case at bar, no question of priority of invention is at issue, and all discussion of Dickinson's reduction to practice is beside the mark.

Furthermore, the grant of a patent raises a presumption of its validity and of the compliance of the patentee with the provisions of the patent statute. (Walker on Patents, 5th Ed., § 491, pp. 557–8.) Therefore, if by any stretch of the imagination a reduction to practice could be considered necessary, there is a presumption that the patentee has done so and respondent must overcome the presumption by proof to the contrary.

However, in the case at bar, the Dickinson patent was in interference in the Patent Office, and the question of reduction to practice was there raised, and was decided favorably to Dickinson. On this point the Examiner of Interferences said: "In the opinion of the Examiner, Dickinson is entitled to date of February, 1900, as the date of his reduction of the invention to practice." (Rec. p. 147.) Also "Dickinson reduced the invention to practice in February, 1900". (Rec. p. 153.) This decision strengthens the presumption in favor of the Dickinson patent (see case

cited on page 25 of petitioner's main brief), which presumption the respondent has done nothing to overcome.

(d) Respondent's Argument that Claim 1 of the Dickinson Patent was Limited by the Words "Oppositely Disposed" and therefore is not Infringed by Respondent's Machine.

Respondent's argument on this point is that claim 1 contains the words "oppositely disposed candy pulling hooks or pins"; that these words refer to the fact that the pair of pins F and F' point in a direction opposite to that in which the stationary candy puller G points; that in respondent's machine the pair of pins 8 and 9 point in the same direction as the candy puller 12, and therefore respondent's machine is outside the terms of the claim. Respondent supplements this argument by pointing out that all the machines of the applications involved in the interference had the pins and the candy puller pointing in opposite directions and concludes that the meaning argued for was imposed upon the claims.

This argument ignores the unmistakable meaning of the words of the claim, which read a "plurality of oppositely disposed candy hooks or pins and a candy puller". The words "oppositely disposed" modify only the words "hooks or pins" and not the word "candy puller". The claim does not read: *a plurality of candy hooks or pins and a candy puller oppositely disposed with respect to each other*, as it would have if the solicitor had intended to express respondent's meaning. Clearly the words as they stand in the claim mean that the pair of pins F and F' are oppositely disposed with relation to each other and not to the candy puller G. Furthermore, this is the arrangement essential to the function of pulling candy since the pins F and F' must be spaced apart from and opposite to each other to permit the candy puller G to pass between

them and seize and pull the strand of candy. The limitation contended for by respondent is therefore contrary to the plain meaning of the words of the claim.

An examination of the file-wrapper and contents of the Dickinson patent and of the decisions in the interference during which the claim was under exacting scrutiny discloses nothing which supports respondent's theory in the remotest degree.

Furthermore, this argument was presented to the Court of Appeals of the Ninth Circuit and considered by it. His Honor, Judge Gilbert, said: "Comparing the Dickinson machine with that of Langer, with reference to claim 1 of the former, we find that Langer's machine has a 'plurality of oppositely disposed candy hooks' . . ." (Rec. p. 339.) Even the Ninth Circuit rejected respondent's finespun theory as contrary to the meaning of the patent in suit.

CONCLUDING SUMMARY.

When the broad and salient facts of this case are passed in review the feebleness of respondent's position is made strikingly apparent. Respondent relies on a mere paper patent which does not have even the essentials of a candy pulling machine to combat the pioneer character of Dickinson's invention, which in a year completely revolutionized the manufacture of pulled candy; he combats the broad phraseology of the claim by violating its evident meaning and arbitrarily reading into it the trough and a meaning for the words "oppositely disposed" which is contradictory to the remainder of the claim; and finally on the question of infringement, having ignored the fact that the infringing machine contains the essential elements of a candy pulling machine, as stated in the claim, he relies on the dissimilarity of appearance and the fact that respondent's machine has a circular movement while the main movements of Dickinson's are in a straight line.

All of respondent's arguments are based on superficial appearance, and studiously ignore the substance.

Therefore, at the risk of repetition, we again state the fundamental considerations which lead petitioner's counsel to believe that the Circuit Court of Appeals for the Ninth Circuit was altogether wrong in its conclusions and ought to be reversed.

Prior to 1900, when Dickinson made his invention, candy had been pulled wholly by hand. Firchau, whose patent was granted in 1893, had made no contribution to the art because his machine was provided with only two pins, while three pins are necessary to produce the peculiar in-and-out motion essential to a successful machine, this combination of pins and peculiar movement being for the first time conceived by Dickinson. Since Dickinson's relative in-and-out motion cannot be produced by less than three candy pulling pins, Firchau's two pin machine cannot anticipate Dickinson's patent or limit the claims.

The respondent employs three pins and the relative in-and-out motion and not two pins. His machine is like the patent in suit and not like the Firchau machine. He has appropriated the substance of Dickinson's invention, and having done so the District Court was right in enjoining him. This Court will look beyond mere externals; it will not regard mere differences in appearance.

The Dickinson claim, which has been fully and unanimously sustained by the three skilled and learned tribunals of the Patent Office, by District Judge Rose and the learned Circuit Court of Appeals for the Fourth Circuit, as well as by other District judges, is for a pioneer invention of great merit, and is to be given the fair and natural meaning of the words employed and not to be narrowed nor restricted unnecessarily. When correctly construed, the claim is infringed by respondent's machine.

It is respectfully submitted that the Circuit Court of Appeals for the Ninth Circuit having reached contrary and erroneous conclusions ought to be reversed.

Respectfully submitted,

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Solicitors and of Counsel for the Petitioner.